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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			COZART, JERMIE E	
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			3726	

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/784,337	<b>Applicant(s)</b> EIDENSCHINK ET AL.	
	<b>Examiner</b> Jermie Cozart	<b>Art Unit</b> 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-36 and 39-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34 is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,12-15,22,29,30,33, 36,39-43,46 and 47 is/are rejected.
- 7) ☒ Claim(s) 8-11,16-21,23-28,31,32,35,44,45,48 and 49 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Allowable Subject Matter*

1. The indicated allowability of claims 1-3, 5-7, 12-15, 22, 29, and 30 is withdrawn in view of the newly discovered reference(s) to Jagger et al. (US 2004/0260379 A1), Jackson et al. (6,082,990), and Richter (5,906,759). Rejections based on the newly cited reference(s) follow.
2. Claims 8-11, 16-21, 23-28, 31, 32, 35, 44, 45, 48, and 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
3. Claims 29, 30, 33, and 36 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
4. Claim 34 is allowed.

### *Claim Objections*

5. Claims 6, 10, 14, 18, 20, 21, 27, and 39-49 are objected to because of the following informalities: In **claim 6**, *line 2*, "configuration the" is objected to because it is grammatically incorrect in the used context, therefore it is suggested to change "configuration the" to - -configuration, the- -; In **claim 10**, *line 2*, "configuration the" is objected to because it is grammatically incorrect in the used context, therefore it is suggested to change "configuration the" to - -configuration, the- -; In **claim 14**, *line 3*, "and" in its first occurrence is objected to because it is grammatically incorrect in the

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context used, therefore it is suggested to delete "and" in its first occurrence, also it is suggested to change "layer" to - -layer,- -; In **claim 18**, *line 3*, "and" in its first occurrence is objected to because it is grammatically incorrect in the context used, therefore it is suggested to delete "and" in its first occurrence, also it is suggested to change "layer" to - -layer,- -; In **claim 20**, *line 9*, "configuration a" is objected to because it is grammatically incorrect in the used context, therefore it is suggested to change "configuration a" to - -configuration, a- -, *line 11*, "configuration the" is objected to because it is grammatically incorrect in the used context, therefore it is suggested to change "configuration the" to - -configuration, the- -; In **claim 21**, *line 3*, "configuration the" is objected to because it is grammatically incorrect in the used context, therefore it is suggested to change "configuration the" to - -configuration, the- -; In **claim 27**, *line 2*, "inject" is objected to because it is the incorrect word used, therefore it is suggested to change "inject" to - -injection- -; In claim 39, *line 7*, "an" is objected to because it is the incorrect word used, therefore it is suggested to change "an" to - -a- -. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 29, 30, 33, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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8. Regarding claim 29, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

9. Regarding claim 30, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

10. Regarding claim 33, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

11. Claim 33 contains the trademark/trade name BAYHDROL®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe polyurethane dispersions and, accordingly, the identification/description is indefinite.

12. Claim 36 recites the limitation "the axis" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1-3, 5-7, 12, 14, 39, 41-43, and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Jagger et al. (US 2004/0260379 A1).

Jagger discloses a system (50) for reducing the cross-sectional surface area of a stent assembly comprising a contracting assembly, the contracting assembly comprising a plurality of moveable contracting members (51), each of the contracting members (51) having a predetermined shape, at least one of the contracting members (51) having a different predetermined shape (i.e. matched pairs of different diameter crimping elements/contracting members) than the predetermined shape of each of the other contracting members (page 4, paragraph [0046]), the plurality of contracting members (51) defining a cross-sectional surface area reduction chamber (fig. 10), the chamber having a reduced cross-sectional surface area configuration and a pre-reduction cross-sectional surface area configuration, the contracting assembly constructed and arranged to receive at least a portion of a stent assembly (25) into the chamber, wherein when the chamber is in the pre-reduction cross-sectional surface

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area configuration the at least a portion of the stent assembly (25) has a first cross-sectional surface area and when the chamber is in the reduced cross-sectional surface area configuration the at least a portion of the stent assembly has a second cross-sectional surface area, the second cross-sectional surface area being less than the first cross-sectional surface area. Jagger discloses a first mandrel (16), a portion of the first mandrel constructed and arranged to be positioned within the cross-sectional surface area reduction chamber, a first portion of the stent assembly (25) disposed about the portion of the mandrel (16). The predetermined shape of the contracting members (51) is substantially rectangular (fig.11). Jagger discloses a stent assembly engagement surface (51) on at least one of the contracting members (51) defines a stair-step area (71, fig. 11). The portion of the first mandrel (16) is expandable from an unexpanded first mandrel diameter to an expanded first mandrel diameter, the expanded first mandrel diameter being greater than the unexpanded first mandrel diameter. The portion of the first mandrel comprises an expandable balloon (16). The portion of the first mandrel is constructed from an elastic layer (page 4, paragraph [0047], lines 1-6).

Regarding **claims 6 and 7**, note that “wherein when the cross-sectional surface area reducing chamber is in the reduced cross-sectional surface area configuration the first mandrel is positioned within the cross-sectional surface area reducing chamber and the portion of the first mandrel is expanded to the expanded first mandrel diameter” and “wherein when the stent assembly is in the second cross-sectional surface area, the portion of the first mandrel is expanded to the expanded first mandrel diameter” are recitations of the intended use, and a recitation of the intended use of the claimed

invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding claim 39, each of the contracting members (51) has an elongate edge (fig. 11) with a predetermined shape, at least one of the contracting members ( ) has a different elongate edge predetermined shape (i.e. matched pairs of different diameter crimping elements/contracting members) than the elongate edge predetermined shape of the each of the other contracting members (page 4, paragraph [0046]).

*See pages 3-4 and figures 1, 2, and 10-12 for further clarification.*

15. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Richter (5,906,759).

Richter discloses a system for reducing the cross-sectional surface area of a stent assembly comprising a contracting assembly, the contracting assembly comprising a plurality of moveable contracting members (316-320), each of the contracting members (316-320) having a predetermined shape, at least one of the contracting members (317) having a different predetermined shape than the predetermined shape of each of the other contracting members (316, 318-320), the plurality of contracting members (316-320) defining a cross-sectional surface area reduction chamber (fig. 27), the chamber having a reduced cross-sectional surface area configuration and a pre-reduction cross-sectional surface area configuration, the contracting assembly constructed and arranged to receive at least a portion of a stent assembly (fig. 5A, 6) into the chamber, wherein when the chamber is in the pre-



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reduction cross-sectional surface area configuration the at least a portion of the stent assembly has a first cross-sectional surface area and when the chamber is in the reduced cross-sectional surface area configuration the at least a portion of the stent assembly has a second cross-sectional surface area, the second cross-sectional surface area being less than the first cross-sectional surface area. Richter discloses a first mandrel (309), a portion (310) of the first mandrel constructed and arranged to be positioned within the cross-sectional surface area reduction chamber (fig. 27), a first portion of the stent assembly (not shown, fig. 27) disposed about the portion of the mandrel (309). *See column 16, line 1 – column 17, line 42, and figures 25-27 for further clarification.*

16. Claim 1, 2, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson et al. (6,082,990).

Jackson discloses a system (fig. 8C, 8D) for reducing the cross-sectional surface area of a stent assembly (10) comprising a contracting assembly, the contracting assembly comprising a plurality of moveable contracting members (24, 26, 28, 82), each of the contracting members (24, 26, 28, 82) having a predetermined shape, at least one of the contracting members (24, 26) having a different predetermined shape than the predetermined shape of each of the other contracting members (28, 82), the plurality of contracting members (24, 26, 28, 82) defining a cross-sectional surface area reduction chamber (not labeled, fig. 8C, 8D), the chamber having a reduced cross-sectional surface area configuration and a pre-reduction cross-sectional surface area configuration, the contracting assembly constructed and arranged to receive at least a portion of a stent assembly (10) into the chamber, wherein when the chamber is in the

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pre-reduction cross-sectional surface area configuration the at least a portion of the stent assembly has a first cross-sectional surface area and when the chamber is in the reduced cross-sectional surface area configuration the at least a portion of the stent assembly has a second cross-sectional surface area, the second cross-sectional surface area being less than the first cross-sectional surface area. Jackson discloses a first mandrel (14), a portion of the first mandrel constructed and arranged to be positioned within the cross-sectional surface area reduction chamber, a first portion of the stent assembly (10) disposed about the portion of the mandrel (14). The predetermined shape of the contracting members (24, 26) is substantially rectangular. Jackson also discloses a protective sheath (20), wherein the protective sheath (20) is disposed about the stent assembly (10). See column 5, lines 26-53; column 8, lines 48-67; and figures 8C-8D for further clarification.

Note “constructed and arranged to be positioned within the cross-sectional surface area reduction chamber” is a recitation of the intended use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### ***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 13, 15, 40, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jagger et al. (US 2004/0260379 A1).

Jagger discloses all of the claimed subject matter except for the following: at least the portion of the first mandrel being at least partially constructed from an electro-active polymer; at least the portion of the first mandrel being constructed from a plurality of layers, the plurality of layers comprising: a conductive layer, a proton exchange layer, a carbon nanotube layer and an elastic membrane layer; or the first cross-sectional shape being generally circular and the second cross-sectional shape being generally ellipsoid shaped.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to construct at least the portion of the first mandrel of Jagger from at least from an electro-active polymer, to construct at least the portion of the first mandrel of Jagger from a plurality of layers, the plurality of layers comprising: a conductive layer, a proton exchange layer, a carbon nanotube layer and an elastic membrane layer, to form the first cross-sectional shape as generally circular and the second cross-sectional shape as generally ellipsoid shaped because Applicant has not disclosed that at least the portion of the first mandrel being at least partially constructed from an electro-active polymer; at least the portion of the first mandrel being constructed from a plurality of layers, the plurality of layers comprising: a conductive layer, a proton exchange layer, a carbon nanotube layer and an elastic membrane layer; or the

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first cross-sectional shape being generally circular and the second cross-sectional shape being generally ellipsoid shaped provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the material and cross-sectional shapes taught by Jagger because the system effectively crimps and retains the stent assembly.

Therefore, it would have been an obvious matter of design choice to modify Jagger to obtain the invention as specified in claims 13, 15, 40, and 47.

### ***Response to Arguments***

19. Applicant's arguments with respect to claims 1-3, 5-7, 12-15, 22, 29, and 30 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited on the attached PTO-892 are cited to show crimping devices with contracting members.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie Cozart whose telephone number is 571-272-4528. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JERMIE E. COZART  
PRIMARY EXAMINER

JC  
July 10, 2006